

REMARKS

In the subject Final Office Action, the Examiner rejected claims 80-100 under 35 USC 103, as being obvious in view of Wycherley et al (US 2002/0030103) and Sylvan combined, substantially on the same ground. The Examiner considered Applicants' argument not persuasive, stating

"Whether or not Sylvan changes the phone function is irrelevant, it was merely stated to further show combinability of the references, and furthermore it does change function of the phone. The combination does show a partial cover. Applicant's sole argument for patentability is partial coverage of phone, which is an obvious design choice, which is demonstrated by Sylvan."

Sylvan's alleged cover is a simple rigid plastic card with openings (see e.g. col. 51-55) for use to superimpose over the display (see e.g. Fig. 5) to help delineate the "soft buttons" of the user interface (see. Fig. 8-9). Applicants continue to fail to see how a simple rigid plastic card with openings, laid over a display, is capable of changing the functions the device. Nevertheless, since the Examiner has modified paragraph 3 of the office action and removed this language from the basis of rejection (notwithstanding the above quoted statement), Applicants assume the Examiner is no longer rely on this alleged teaching of Sylvan, accordingly, the issue is moot.

The Examiner in the above quoted response, then went on and stated that the Wycherley and Sylvan combination showed a partial cover. But that is insufficient to sustain a rejection, as independent claims 80, 86 and 94 do not claim all partial covers with electronic components having logic/data to modify the functions of the recipient device. Independent claims 80, 86 and 84 claim a partial cover with electronic components having logic/data to modify the functions of the recipient device that partially covers a portion of the front surface NOT occupied by the display and the keys. Sylvan's cover covers the display. Thus, combination of Wycherley and Sylvan would

merely result in a partial front cover that covers the display, which is NOT what's being claimed by independent claims 80, 86 and 84.

The Examiner also made the comment that partial cover is "an obvious design choice". That's a conclusionary assertion. The Examiner is not at liberty to apply his/her subjective assessment of the merits of a claimed invention. The proper legal analysis is whether one of ordinary skill in the art would be motivated by Sylvan or otherwise to modify Wycherley with Sylvan to arrive at the present invention. Such proper legal analysis clearly shows the answer to be NO.

Wycherley itself, as a pioneer in teaching the employment of embedded electronic component with data/logic to modify the device, did not provide any suggestion that the personalization may be practiced with anything other than the disclosed full size front cover. The lack of usability of the full size front cover approach was clearly not readily apparent to Wycherley. Sylvan itself also does not speak to any of the usability problems that exist with a full size front cover. Thus, neither provides any motivation to modify Wycherley.

Even if we are to assume arguendo, somehow, a person of ordinarily skill recognizes the lack of usability of Wycherley's full size front cover approach, and is motivated in search of a solution to improve Wycherley, a person of ordinarily skill in the art would not look to Sylvan for guidance, as it is merely directed towards making the "soft buttons" of a user interface more user friendly.

Moreover, for the logic/data embedded in the electronic component of the full size front cover to modify the function of the device, the logic/data must be transferred into the device. Such transfer must be done through a contact or contactless interface. It is physically impossible to have a contact interface through a display (which is where Sylvan's "cover" is located). Similarly, because of the amount of electromagnetic emissions from the display, it would be a very poor region of the device to place a cover with a contactless interface to communicate with the antenna of the device.

Accordingly, no motivated person of ordinarily skill in the art would combine Sylvan with Wycherley or look to Sylvan for ideas to modify Wycherley to arrive at the claimed invention.

Even if the person did, as discussed earlier a direct combination would still not arrive at the claimed invention, as the combination would be a partial cover that covers the display, and NOT a region of the front surface NOT occupied by the display and keyboard.

Applicants submit any assertion to the contrary is an impermissible use of hindsight of Applicants' teachings.

Accordingly, claims 80, 86 and 94 are patentable over the cited references.

Claims 81-85, 87-93 and 95-100 are dependent on claims 80, 86 and 94 respectively, incorporating their limitations. Therefore, by virtue of at least the dependency, claims 81-85, 87-93 and 95-100 are also patentable over the cited references.

In view of the foregoing, allowance of claims 80-100, and early issuance of Notice of Allowance are respectfully requested.

Please charge any shortages and credit any overages to Deposit Account No. 500393.

Respectfully submitted,
Schwabe, Williamson & Wyatt, P.C.

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By: Aloysius AuYeung
Aloysius AuYeung
Reg# 35,432